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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/714,316 11/16/00 JUSTEN

T US-1483

EXAMINER

PM82/1019

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ART UNIT

PAPER NUMBER

3617  
DATE MAILED:

10/19/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/714,316

Applicant(s)

Justen et al.

Examiner

Ajay Vasudeva

Art Unit

3617



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 20) ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the following must be shown or the feature(s) canceled from the claim(s).

All limitations, as claimed in claims 9-30, must be shown in sufficient detail. Specifically, the air inlet pipe and the tuning tube must be clearly shown in relation with the cover of the outboard motor, as well as with the air intake manifold of the engine.

No new matter should be entered.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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3. Claims 1-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1 (line 5), use of “said air inlet passage” (emphasis added) is indefinite as it lacks proper antecedent basis in the claim.

In claim 2 (line 2), use of “said air intake pipe” (emphasis added) is indefinite as it lacks proper antecedent basis in the claim.

In claim 7 (line 2), use of “air inlet tube” (emphasis added) is indefinite as it lacks proper antecedent basis in the claim. Changing “tube” to -- pipe -- will overcome this rejection.

Additionally, in claim 8, applicant must correspondingly change “inlet tube” to -- inlet pipe --.

In claim 9 (line 10), use of “said air inlet passage” (emphasis added) is indefinite as it lacks proper antecedent basis in the claim.

In claims 10-14, use of “A motor cover” is indefinite. The preamble of the dependent claims should be same as the preamble of the independent claim 9, which is “A cover”.

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In claims 15-20, use of “An air intake silencer” is indefinite. The preamble of the dependent claims should be same as the preamble of the independent claim 9, which is “A cover”.

In claim 15 (line 2), use of “said air intake pipe” (emphasis added) is indefinite as it lacks proper antecedent basis in the claim.

In claim 20 (line 2), use of “air inlet tube” (emphasis added) is indefinite as it lacks proper antecedent basis in the claim.

In claim 21 (line 4), use of “air inlet pipe coupled to said air inlet pipe” (emphasis added) is indefinite because of a typographical error. Deleting the underlined word will overcome this rejection.

In claim 22 (line 2), use of “said air intake pipe” (emphasis added) is indefinite as it lacks proper antecedent basis in the claim.

In claim 23 (line 2), use of “in flow ...with inlet pipe passage” is indefinite as the use of such limitation is inferential. Inserting -- an -- before “inlet pipe” will overcome this rejection.

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In claim 27 (line 2), use of “air inlet tube” (emphasis added) is indefinite as it lacks proper antecedent basis in the claim. Changing “tube” to -- pipe -- will overcome this rejection.

Additionally, in claim 28, applicant must correspondingly change “inlet tube” to -- inlet pipe --.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-5, 7 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 60-022021.

JP 60-022021 shows an air intake silencer for an internal combustion engine, generally as claimed, having a straight inlet pipe [13] with an inlet passage, and a tuning tube [19] with a tuning passage in fluid communication with the inlet passage.

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6. Claims 1-3, and 5-8 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 03-229908.

JP 03-229908 shows an air intake silencer for an internal combustion engine (figure 11), generally as claimed, having a straight inlet pipe [6] with an inlet passage, a first tuning tube [3] with a tuning passage in fluid communication with the inlet passage, and a second tuning tube [1] in a wrap-around relationship with the first tuning tube.

7. Claims 1, 2, and 5-8 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 05-163925.

JP 05-163925 shows an air intake silencer for an internal combustion engine (figure 4), generally as claimed, having a straight inlet pipe [1] with an inlet passage, a first tuning tube [4] with a tuning passage in fluid communication with the inlet passage, and a second tuning tube [2] in a wrap-around relationship with the first tuning tube.

Art Unit:

8. Claims 1-5, 7 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 60-022021.

JP 60-022021 shows an air intake silencer for an internal combustion engine, generally as claimed, having a straight inlet pipe [13] with an inlet passage, and a tuning tube [19] with a tuning passage in fluid communication with the inlet passage.

*withdrawn*  
9-18  
9. Claims 1, 3, 5, 7-11, 14, 16, 18, 21, 23, 25, 28 and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Nakayasu et al.

Nakayasu et al. shows an air intake silencer for an outboard motor (figure 2), generally as claimed, having lower and upper covers [52, 18], an air intake silencer [55] attached to the cover, a inlet pipe [66] with an inlet passage, and a tuning tube [65] with a tuning passage in fluid communication with the inlet passage. The air intake silencer is in attachment with the top as well as the side walls of the covers. The inlet pipe comprise an air intake manifold. The intake tube and the tuning tube have substantially equal diameters.



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10. Claims 1-5, 8-18, 21-25, and 28-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Kiekhaefer ('470).

Kiekhaefer ('470) shows an air intake silencer for an outboard motor (figure 3), generally as claimed, having lower cover, an upper cover, an air intake silencer [15] integrally attached to both the upper and lower covers, a straight inlet pipe [21] with an inlet passage, and a tuning tube [36] with a tuning passage in fluid communication with the inlet passage. The air intake silencer is in attachment with the top, bottom, as well as the side walls of the covers. The inlet pipe comprise an air intake manifold. The tuning tube has three segments in flow communication with each other, and disposed horizontally, and parallel along a horizontal axis passing through the inlet pipe. The intake tube and the tuning tube have substantially equal diameters.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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12. Claims 1-5, 7, 8-12, 16-18, 20, 21, 23, 24, 25, 27 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mondek ('847) in view of JP 60-022021.

Mondek discloses an outboard motor with an internal combustion engine, having air inlet pipe connected to a cover for the motor at a top wall of the cover (figure 6), a bottom wall (figure 5), or side wall (figure 11) for supplying air.

Mondek is silent on a provision of a tuning tube for the inlet pipe supplying air to the internal combustion engine.

JP 60-022021 shows an air intake silencer for an internal combustion engine having a tuning tube attached to the inlet tube, as described above.

It would have been obvious for one skilled in the art at the time of the invention to attach a tuning tube to the inlet tube of Mondek, as taught by JP 60-022021. Integrating a tuning tube to the inlet tube would provide the benefits of lowering the noise level of the engine at varied engine speeds.

Regarding claims 20 and 27, it would have been obvious for one skilled in the art to manufacture the inlet tube integrally with the tuning tube as one unit. Making both tubes integral as a single unit would reduce the number of components, thus reducing assembly time and labor.

Art Unit:

13. Claims 1-3, 5-12, 16, 18-21, 23, 25-27 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mondek ('847) in view of JP 03-229908.

Mondek discloses an outboard motor with an internal combustion engine and an air inlet pipe, as above.

Mondek is silent on a provision of a tuning tube for the inlet pipe supplying air to the internal combustion engine.

JP 03-229908 shows an air intake silencer for an internal combustion engine having a first tuning tube, and a second tuning tube in a wrap-around relationship with the first tuning tube, as described above.

It would have been obvious for one skilled in the art at the time of the invention to attach a tuning tube to the inlet tube of Mondek, as taught by JP 03-229908. Integrating a tuning tube to the inlet tube would provide the benefits of lowering the noise level of the engine at varied engine speeds.

Regarding claims 20 and 27, it would have been obvious for one skilled in the art to manufacture the inlet tube integrally with the tuning tube as one unit. Making both tubes integral as a single unit would reduce the number of components, thus reducing assembly time and labor.

Art Unit:

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Takahashi et al., Toyama, Tsunoda, Tsunoda et al., Furukawa, Boda, Mondek ('070), Okazaki et al., JP ('838), JP ('942), JP ('421), JP ('961), JP ('970), JP ('754), JP ('226), JP ('491), JP ('493) describe noise silencers for air intakes.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ajay Vasudeva whose telephone number is (703) 306-5992.



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AV

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